

U.S. Patent Application No. 10/806,080
Amendment dated June 28, 2006
Response to Office Action dated March 23, 2006

REMARKS/ARGUMENTS

Reconsideration and continued examination of the above-identified application are respectfully requested.

In the amendment, claim 1 has been canceled. Claims 154, 158, 183, 186, and 187 have been amended to replace the term "obtainable" with the term "obtained." The scope of these claims remains the same. A minor editorial correction was made to claim 171. Further, new claims 199-212 have been added by way of this amendment. Full support for this subject matter can be found throughout the present application including, but not limited to, page 7, beginning at line 3 to line 29. Accordingly, no questions of new matter should arise and entry of this amendment is respectfully requested.

Rejection of Claims 154, 158, 186, and 187 Under 35 U.S.C. §112 – Second Paragraph

At page 2 of the Office Action, the Examiner rejects claims 154, 158, 186, and 187 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner has requested that the term "obtainable" be replaced with the term "obtained by." For the following reasons, this rejection is respectfully traversed.

Since the scope of the claim remains the same, this term has been replaced in each of the claims as requested by the Examiner. Accordingly, this rejection should be withdrawn.

Double Patenting Rejection of Claim 1

At the bottom of page 2 of the Office Action, the Examiner rejects claim 1 under 35 U.S.C. §101 as claiming the same invention as claim 1 of U.S. Patent No. 5,851,280. For the following reasons, this rejection is respectfully traversed.

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Claim 1 has been canceled. Accordingly, this rejection should be withdrawn.

Non-Statutory Obviousness-Type Double Patenting Rejections

At page 3 of the Office Action, the Examiner rejects claims 1 and 154-179 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,554,739; over claims 1-21 of U.S. Patent No. 5,707,432; over claims 1-53 of U.S. Patent No. 5,851,280; over claims 1-46 of U.S. Patent No. 6,042,643; and over claims 1-25 of U.S. Patent No. 6,740,151. The Examiner further rejected claims 180-198 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,559,169; over claims 47-70 of U.S. Patent No. 6,042,643; over claims 21-31 of U.S. Patent No. 5,900,029; or over claims 27-45 of U.S. Patent No. 6,740,151. The Examiner asserts that although the conflicting claims are not identical, they would not be patentably distinct. For the following reasons, this rejection is respectfully traversed.

Though the applicants do not agree with the Examiner and believe the claims can be considered patentably distinct, to expedite the prosecution of this application and without agreeing to the substance of the rejections, a Terminal Disclaimer is being submitted in view of most of the cited patents, except as stated below.

With respect to the Examiner's rejection of the claims in view of U.S. Patent No. 5,554,739, the applicants cannot agree. The claims of the '739 are all process claims and, furthermore, the claims do not recite carbon black, but only other carbon materials. See claim 1 of the '739 patent. Accordingly, due to this patentably distinct subject matter, process claims versus product claims (only claim 179 is a process claim in the present application directed to a specific organic group), and since the claims of the '739 patent do not recite carbon black, this rejection would not be proper

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with respect to the '739. With respect to U.S. Patent No. 5,559,169, all of the claims set forth in this patent are rubber composition claims. It appears that the Examiner may be comparing the particular attached organic group referred to in the claims of the '169 patent with the subject matter set forth in claims 177 and 178. However, these claims refer to carbon black and not to rubber compositions. Furthermore, none of the remaining claims, namely claims 180-198 refer to these claims in the context of a rubber composition. Thus, it is not understood how the subject matter of claims in the '169 patent would render obvious the pending claims.

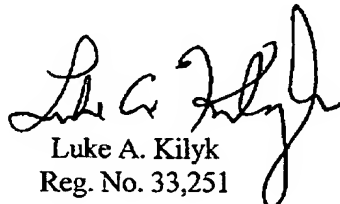
Accordingly, in view of the Terminal Disclaimer and the above comments, this rejection should be withdrawn.

CONCLUSION

In view of the foregoing remarks, the applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,


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